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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,994	11/26/2003	Tomohiro Miyashita	XA-9999	6540
181	7590	11/27/2006	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/721,994	MIYASHITA, TOMOHIRO
	Examiner	Art Unit
	Joshua L. Pritchett	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 13 October 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 3-8, 10, 11, 20, 21 and 23-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 3, 4, 7, 8, 10, 11, 23 and 25 is/are allowed.  
 6) Claim(s) 5, 6, 20, 21 and 24 is/are rejected.  
 7) Claim(s) 26 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

This action is in response to Amendment filed October 13, 2006. Claims 3, 5, 23 and 24 have been amended, claims 12-18 have been cancelled and claims 25 and 26 have been added as requested by the applicant.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, 6 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaneko (US 2003/0123145).

Regarding claim 5, Kaneko discloses a microscope system (Fig. 3) comprising an objective lens (1b) and an intermediate magnification varying part (10) disposed just after the image side of the objective lens to vary magnification of a sample observed through the objective lens (Fig. 3; para. 0046) wherein the intermediate magnification varying part is constructed in such a way that its optical system is rotatable relative to an optical axis of the objective lens with an axis substantially orthogonal to the optical axis of the objective lens being a rotation axis (Fig.

3). The intermediate magnification varying part rotates about an axis into the page as shown in Fig. 3.

Regarding claim 6, Kaneko discloses the microscope optical system is provided with a connecting portion on the image side of the intermediate magnification varying part and the microscope optical system can be connected with a body of a microscope by means of the connecting portion (Fig. 3). The intermediate magnification varying portion is optically connected to the prism 1c as shown in Fig. 3

Regarding claim 24, Kaneko discloses an optical axis of the intermediate magnification varying part is aligned with the optical axis of the objective lens and the intermediate magnification varying part is constructed to be rotated by 180-degrees about the rotation axis at a point on the optical axis of the intermediate magnification varying part (Fig. 3; para. 0046).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko (US 2003/0123145) in view of Yonezawa (US 6,320,702).

Kaneko teaches the invention as claimed but lacks reference to the claimed magnification stated ratios. Yonezawa teaches moving lenses within the intermediate magnification varying part along the optical axis to change the magnification (abstract). After combining the teachings of both Kaneko and Yonezawa one of ordinary skill in the art would be able to set the magnification to a wide variety of settings, which depending on the preference of the operator would fall within the claimed magnification ranges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Kaneko invention include the movable lenses of Yonezawa in the intermediate magnification varying part for the purpose of allowing both rough and fine tuning adjustments to the magnification state of the microscope to allow observation of large areas and quickly be able to zoom in or out of smaller areas within the large area of observation.

***Allowable Subject Matter***

Claims 3, 4, 7, 8, 10, 11, 23 and 25 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 3, the prior art fails to teach or suggest a microscope with an objective lens and an intermediate magnification varying part which varies the magnification of an image observed through the objective lens, wherein the intermediate magnification varying part has a

positive power lens group and a negative power lens group and in a high magnification state the positive power lens group is just after the objective lens and in the low magnification state the negative power lens group is just after the objective lens and the intermediate magnification varying part is rotatable about an axis orthogonal to the optical axis of the objective lens.

The remaining claims depend from claim 3 and are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to teach or suggest wherein the intermediate magnification varying part has a positive power lens group and a negative power lens group and in a high magnification state the positive power lens group is just after the objective lens and in the low magnification state the negative power lens group is just after the objective lens and the intermediate magnification varying part rotates 180-degrees to switch between the high and low magnification states.

***Response to Arguments***

Applicant's arguments, see Amendment, filed October 13, 2006, with respect to claim 3 have been fully considered and are persuasive. The rejection of claim 3 has been withdrawn. Applicant amended the claim language to require the intermediate magnification varying part is rotatable separately from the objective lens.

Applicant's arguments, see Amendment, filed October 13, 2006, with respect to the rejection(s) of claim(s) 5 under Otaki have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kaneko. Applicant amended the claim language to require the intermediate magnification varying part is rotatable separately from the objective lens. However, claim 5 does not include all the limitations of claim 3 and the Kaneko reference has been added to teach the limitations of claim 5.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DREW A. DUNN  
SUPERVISORY PATENT EXAMINER

Joshua L Pritchett  
Examiner  
Art Unit 2872